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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,504	06/26/2003	James P. Peterson	200920-9007	5220

1131 7590 02/07/2007  
MICHAEL BEST & FRIEDRICH LLP  
Two Prudential Plaza  
180 North Stetson Avenue, Suite 2000  
CHICAGO, IL 60601

EXAMINER
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SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/606,504

Applicant(s)

PETERSON, JAMES P.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35 and 38-55 is/are pending in the application.
- 4a) Of the above claim(s) 35 and 47-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's response filed on 11/22/2006 has been fully considered. Claims 35 and 38-55 are pending. (NOTE: Claims 35 and 47-55 are withdrawn from consideration as non-elected invention).

### ***Election/Restrictions***

2. Applicant's election without traverse of Group I claims 38-46 in the reply filed on 11/22/2006 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 38-42 and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US 4,946,532).

5. A multilayer web construction comprising a release liner, a release coating (R) on the release liner, an adhesive coating (s) on the release coating (R), and a facestock on the adhesive coating (s), wherein the facestock is die-cut to form pressure sensitive labels (Fig. 3A-3D and col. 6, line 21). The facestock is equivalent to the claimed card, and the release liner is equivalent to the claimed backing. The facestock may comprise polyvinylchloride (col. 10, line 14 and col. 11, line 26-28), and may be corona treated to

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increase printability of the layer (col. 10, line 23). Roughness at a face may be provided by embossing effect (col. 8, line 52). Freeman further discloses cutting the facestock and decorating using screen printing method (col. 7, line 36).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 4,946,532), as applied to claims 38-42 and 44-46, above.

8. Freeman discloses the claimed invention except for slots or holes in the pressure sensitive labels. It would have been obvious matter of design choice to make slots or holes in the labels, since applicant has not disclosed that the slots and holes solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the slots and holes.

### ***Response to Arguments***

9. Applicant's argument is based on that the reference does not teach forming image after cutting. This argument is not persuasive because Freeman teaches cutting the facestock and decorating using screen printing method, and the examiner in this case interprets decorating as printing).

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10. Applicant further argues that the Examiner has not considered the claim limitation of "card" or "card printer". This argument is not persuasive because Even though Freeman refers to web construction, the facestock is cut into segments. However, the term "card" does not preclude such segments. Furthermore, the current specification does not clearly define the term "card"; for example, thickness, size, stiffness.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claim 38-40, 42, 45 and 46 are rejected under 35 U.S.C. 102(a) as being anticipated by Popat (US 5,99,683).

13. Popat discloses method of forming printed label sheet comprising providing a backing sheet, applying a label sheet over the backing sheet, die cutting the label sheet with out cutting the backing sheet to form plurality of labels, and feeding the sheet into a printer to form a printed matter on the sheet. See Fig. 4, Fig. 8, and all claims.

14. Claim 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Popat (US 5,997,683), as applied to claims 38-40, 42, 45 and 46, above.

15. Popat discloses the claimed invention except for slots or holes in the pressure sensitive labels. It would have been obvious matter of design choice to make slots or

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holes in the labels, since applicant has not disclosed that the slots and holes solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the slots and holes.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BS  
February 5, 2007.

  
BETELHEM SHEWAREGED  
PRIMARY EXAMINER